

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent application of :
Won-suk Yang et al. : Group Art Unit: 2814
Application No. 09/313,659 : Examiner: Kalam, Abul
Filed May 18, 1999 : Confirmation No. 4199

METHOD FOR FABRICATING A SEMICONDUCTOR DEVICE

**PETITION REQUESTING ISSUANCE OF
ACTION ON THE MERITS**

U.S. Patent and Trademark Office
E-FILING
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants, by the undersigned, hereby request that the appropriate Patent Office personnel be directed to issue an action on the merits in the above-identified application. Specifically, Applicants have still not received an action on the merits subsequent to the decision mailed February 8, 2008 (copy attached). That decision was responsive to Applicant's previous petition of August 28, 2007 (copy attached).

Respectfully submitted,
VOLENTINE & WHITT, PLLC
/Adam C. Volentine/

Adam C. Volentine
Reg. No. 33289

ATTACHMENTS: Decision of 2/8/08
Petition of 8/28/07

Customer No. 20987
11951 Freedom Drive, Suite 1200
Reston, VA 20190
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Date: June 22, 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/313,659

05/18/1999

WON-SUK YANG

SEC.636

4199

20987 7590 02/14/2008
VOLENTINE & WHITT PLLC
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11951 FREEDOM DRIVE SUITE 1260
RESTON, VA 20190

EXAMINER

KALAM, ABUL

ART UNIT

PAPER NUMBER

2814

MAIL DATE

DELIVERY MODE

02/14/2008

PAPER

RECEIVED
FAX ORIGINAL
FEB 15 2008
VOLENTINE & WHITT,
PLLC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Central Docket 2/18/08 MC

Atty. Docket N/A N/A

Admin. Docket N/A N/A

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09313659	5/18/1999	YANG ET AL.	SEC.636

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EXAMINER

ABUL KALAM

ART UNIT	PAPER
2814	20080208

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The petition filed on August 28, 2007, to invoke supervisory authority is hereby treated as a request for reconsideration. Upon Applicant's request, the instant application was assigned to a new examiner. Furthermore, note that in the petition decision mailed on July 8, 2005, the Notice of Abandonment made by the previous examiner was vacated and the application was restored to pending status. To clarify the record, the Examiner's Amendments, and the comments made therein, on April 11, 2001, and on August 03, 2001, were vacated. The Notice of Allowance mailed on April 11, 2001, was also vacated and the indicated allowance of claims was withdrawn.

However, in order to make the record clear, the new examiner requests that the Applicant file an updated set of all the claims, that reflect the current status of the claims, before an action on the merits is made.

/A. K./
Examiner, Art Unit 2814

/Phat X Cao/
Primary Examiner, Art Unit 2814

Electronic Acknowledgement Receipt

EFS ID:	2130474
Application Number:	09313659
International Application Number:	
Confirmation Number:	4199
Title of Invention:	METHOD OF FABRICATING A MOS TRANSISTOR WITH DOUBLE SIDEWALL SPACERS IN A PERIPHERAL REGION AND SINGLE SIDEWALL SPACERS IN A CELL REGION
First Named Inventor/Applicant Name:	WON-SUK YANG
Customer Number:	20987
Filer:	Adam Carson Valentine.
Filer Authorized By:	
Attorney Docket Number:	SEC.636
Receipt Date:	28-AUG-2007
Filing Date:	18-MAY-1999
Time Stamp:	13:32:04
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes) /Message Digest	Multi Part /.zip	Pages (if appl.)
1	Petition for review by the Office of Petitions.	Petition.pdf	252108	no	8
			2a74cda3407155905a0c245fca1688139f5c0a9		

Warnings:

Information:**Total Files Size (in bytes):**

252108

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent application of :
Won-suk Yang et al. : **MAIL STOP PETITIONS**
Serial No. 09/313,659 : **OFFICE OF PETITIONS**
Filed May 18, 1999 :
METHOD OF FABRICATING A MOS TRANSISTOR ...

**PETITION TO INVOKE THE SUPERVISORY
AUTHORITY OF THE DIRECTOR**

U.S. Patent and Trademark Office

E-FILING

Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants, by the undersigned, hereby respectfully petition the Director to (a) re-assign responsibility for the subject application to a new Examiner, and (b) direct the newly assigned Examiner to promptly issue an Office action on the merits in connection with the subject application.

I. STATEMENT OF FACTS

The facts related to this Petition are as follows:

1. On July 11, 2001, Applicants filed a Petition (the first Petition) asking for, among other things, withdrawal of an unauthorized Examiner's Amendment.
2. The Office never issued a response to the first Petition, and indeed, it appears from the record that Examiner simply placed the first Petition in the Office file without formal entry of the same¹.

¹ See page 2 of a later-issued Decision on Petition dated July 8, 2005.

3. On April 17, 2002, Applicants filed another Petition (the second Petition) asking for withdrawal of a clearly improper holding of abandonment².
4. Once again, the second Petition was placed in the Office file but not considered³.
5. On August 9, 2004, Applicants filed another Petition (the third Petition), asking for a formal response to the second Petition.
6. On July 8, 2005, the Office issued a Decision on Petition, which essentially granted the relief requested by Applicants in the three previously filed Petitions. For convenience, a copy of the Decision is attached. The Decision concluded by stating that the "application will be returned to the examiner for further prosecution."
7. On November 20, 2006, Applicants filed a first Status Inquiry, reminding the Examiner of the July 8, 2005, Decision on Petition, and asking the Examiner for an indication as to when an Office action is anticipated.
8. No communication was ever received in response to the first Status Inquiry.
9. On January 19, 2007, Applicants filed a second Status Inquiry, again asking the Examiner for an indication as to when an Office action is anticipated.
10. No communication was ever received in response to the second Status Inquiry.
11. On March 21, 2007, Applicants filed a third Status Inquiry, once again asking the Examiner for an indication as to when an Office action is anticipated.
12. No communication was ever received in response to the third status inquiry.

II. REQUEST TO ASSIGN THE SUBJECT APPLICATION TO A NEW EXAMINER

Applicants do not take this request lightly. However, the facts speak for themselves. Indeed, while Applicants are not privy to the Examiner's mindset, it appears from the record that the Examiner refuses to take any further action in this application.

² The abandonment resulted in part from the failure to act on the first Petition.

³ See page 2 of the Decision on Petition dated July 8, 2005.

That is, subsequent to the Decision on Petition which detailed a number of improper actions, the Examiner has since then failed to take any action in this application for over two (2) years. In addition, the Examiner has not responded to three (3) status inquiries filed by Applicants.

In fact, Applicants have not received a single communication directly from Examiner for over six (6) years.

Assigning this Application to a new Examiner is a reasonable request which Application believe should be granted.

III. REQUEST TO DIRECT THE (NEW) EXAMINER TO ISSUE AN IMMEDIATE OFFICE ACTION

Once again, the facts speak for themselves.

Whether or not a new Examiner is assigned, Applicants are entitled to an immediate action on the merits (indeed, it appears that a Notice of Allowance is in order). More than two (2) years have passed since the Decision on Petition, and more than six (6) years have passed since any action on the merits.

IV. FEE

The undersigned does not believe that a U.S.P.T.O. fee is applicable to the filing of a Petition of this nature. However, in the event that the undersigned is mistaken, the Director is hereby authorized to charge any applicable fee or fees to Deposit Account No. 50-0238.

V. DUPLICATE COPY OF THIS PETITION FILED BY FACSIMILE

Applicants are understandably concerned that this Petition may fail to reach someone in the Patent Office with decision-making authority. Accordingly, in addition to "e-filing" of the original, a duplicate copy of this Petition is being fax'd directly to the Office of Petitions at **571-273-0025**.

Respectfully submitted,

VOLENTINE & WHITT, PLLC

/Adam C. Volentine/

Adam C. Volentine
Reg. No. 33289

August 28, 2007

Attachment: Copy of Decision on Petition dated June 8, 2005

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JUL 12 2005

Paper No. 17

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Received

JUL 08 2005

In re Application of:
Won-Suk YANG et al.
Serial No.: 09/313,659
Filed: May 18, 1999
Attorney Docket No.: SEC.636

DECISION ON PETITION
TO WITHDRAW HOLDING OF
ABANDONMENT

This is a decision on the petition filed July 11, 2001, to withdraw the unauthorized examiner's amendment and reopen prosecution, the petition filed April 17, 2004 to withdraw the improper holding of abandonment under 37 C.F.R. § 1.181 and the petition filed August 9, 2004, to invoke supervisory authority under 37 C.F.R. § 1.181, and to withdraw the holding of abandonment. All of the petitions will be treated herein.

The petitions are **GRANTED**.

The application was held abandoned for failure to timely pay the issue fee in response to the Notice of Allowance and Issue Fee Due (Notice of Allowance) mailed on April 11, 2001, setting a three-month statutory period to pay the issue fee. The issue fee was not paid, but a petition to withdraw an unauthorized examiner's amendment and reopen prosecution was filed instead on July 11, 2001, the due date of the issue fee. A Notice of Abandonment was subsequently mailed on October 10, 2001.

BACKGROUND

Petitioner asserts that the examiner of record issued an improper Final Rejection on January 25, 2001 by applying a new rejection to claim 15, which had not been amended in a previous response. During conversations with the examiner on March 1, 2001 and March 7, 2001, petitioner claims to have discussed the finality of the office action with the examiner and that the examiner did not wish to withdraw the finality of the office action unless a written request was filed. It was, however, agreed to that claims 1 - 19 were patentable over the cited prior art but

claims 9 and 19 still had a pending 35 U.S.C. § 112, first paragraph, new matter rejection. The examiner proposed deleting any reference to BF₂ in the claims to place the application in condition for allowance. Petitioner states that he told the examiner that he would pass this request on to the Applicants for review but did not agree to the proposed amendments.

Petitioner then received a Notice of Allowance, mailed April 11, 2001, with an Examiner's Amendment deleting the references to BF₂ in claims 9 and 19 and reinserting a reference to BF₃ in claim 18. Although claim 18 had not been rejected under 35 U.S.C. § 112, first paragraph, and contained no reference to BF₂, it appears (although unclear) from the examiner's amendment that the reference to BF₃ was reinserted. Petitioner filed a Letter on April 19, 2001 describing the content of the conversations on March 1, 2001 and March 7, 2001 and asserting that the Examiner's Amendment was unauthorized.

Petitioner next filed a petition on July 11, 2001, the date the issue fee was due, to (a) withdraw the unauthorized Examiner's Amendment, and (b) reopen prosecution so as to properly resolve the issues surrounding the 35 U.S.C. § 112, first paragraph, rejection of claims 9 and 19. Petitioner also requested that the Notice of Allowance of April 11, 2001 be withdrawn. In the alternative, petitioner authorized the charge of the issue fee if necessary to maintain the pendency of the application and provided the deposit account number. This petition is date stamped July 11, 2001.

A review of the file record indicates that this petition was placed in the file but was not entered or considered. However, the examiner wrote in the left hand margin of the petition to see the Supplemental Notice of Allowance of August 2, 2001, subsequently mailed on August 3, 2001. With this Supplemental Notice of Allowance the examiner provided a Supplemental Examiner's Amendment replacing all references to BF₃ with BF₂ stating that "[a]lthough the above changes do not find literal support in the specification, the applicant's error corrected here is one that is self-evident and therefore is not new matter, BF₃ is a neutral compound whereas "BF₂" is an ion that is commonly used for implantation of boron into semiconductor substrate". Petitioner was apparently not consulted with respect to this amendment.

Petitioner received the Notice of Abandonment on October 10, 2001 for failure to timely pay the issue fee in response to the Notice of Allowance mailed on April 11, 2001.

Petitioner then filed a petition to withdraw improper holding of abandonment on April 17, 2002 noting that petitioner had not received a formal decision on the petition filed July 11, 2001. Petitioner also noted that the improper Examiner's Amendment was not withdrawn until after the issue fee was due and the examiner did not extend the courtesy of also withdrawing and then re-dating the Notice of Allowance. Petitioner provided a postcard receipt showing proper receipt of the petition filed July 11, 2001 and a postcard receipt showing receipt of a PTOL-85B Issue Fee Transmittal on August 21, 2001. A review of the file record does not reveal the Submission of Form PTOL-85B. This petition has been entered in the file but not considered.

Petitioner then filed the petition of August 9, 2004 to withdraw the improper holding of abandonment under 37 C.F.R. § 1.181. This petition includes the petition filed on April 17,

2002, the Submission of Form PTOL-85 on August 21, 2001, the petition filed on July 11, 2001, and the Letter filed on April 19, 2001, all properly date stamped.

OPINION

Improper Final Rejection

- MPEP 706.07(a) - examiner may not make final if new ground of rejection
- MPEP 706.07(c) - premature final rejection - Any question as to prematureness of a final rejection **should** be raised, if at all, while the application is **still pending before the primary examiner**. This is purely a question of practice, wholly distinct from the tenability of the rejection.
- MPEP 706.07(d) - If, on **request by applicant** for reconsideration, the primary examiner finds the final rejection to have been premature, he or she **should withdraw the finality** of the rejection. The finality of the Office action **must** be withdrawn while the application is still pending. The examiner cannot vacate the final rejection once the application is abandoned. Form paragraph 7.42 should be used when withdrawing the finality of the rejection of the last Office action.

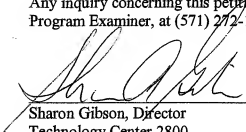
Unauthorized Examiner's Amendment

- MPEP 1302.04 - must be **authorized**
- MPEP 1302.14 -
 - It should also specify that comments may be filed by the applicant on the statement and **should preferably** be submitted with the payment of the issue fee so as not to delay processing of the application and in **any event no later than payment** of the issue fee.
 - Comments filed by the applicant on the examiner's statement of reasons for allowance, **should preferably be submitted no later than the payment** of the issue fee, to avoid processing delays. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

A review of the application file wrappers reveals that the application was not clearly in condition for allowance, in that all issues had been resolved, at the time of mailing the first Notice of Allowability on April 11, 2001. As such, the mailing of the Notice of Allowance was premature. Accordingly, the abandonment of the application was premature.

For the above stated reason, the petitions are granted. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status. In order to clarify the record, the Examiner's Amendments, and the comments made therein, on April 11, 2001, and on August 03, 2001, are hereby vacated. The Notice of Allowance and Issue Fee Due mailed on April 11, 2001 is hereby vacated and the indicated allowance of the claims is hereby withdrawn. The application will be returned to the examiner for further prosecution.

Any inquiry concerning this petition should be directed to Clayton E. LaBalle at, Special Program Examiner, at (571) 272-1594.



Sharon Gibson, Director
Technology Center 2800